Paper No. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ATHLETIC ALTERNATIVES INC.

Appeal No. 98-1857
Reexamination Control No. 90/004,388[1]

HEARD: July 15, 1998

Before McCANDLISH, Senior Administrative Patent Judge, and MEISTER and STAAB, Administrative Patent Judges.

McCANDLISH, Senior Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the examiner's final rejection of claims 1, 2, 8 and 9 under 35 U.S.C. § 102(b). The only other claims still pending in this reexamination

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[1] Request filed October 7, 1996, for reexamination of U.S. Patent No. 5,197,731, granted March 30, 1993, based on Application 07/740,336, filed August 5, 1991. According to appellant, the application is a continuation of Application 07/233,228, filed August 18, 1988, now Patent No. 5,037,097, granted August 6, 1991.

proceeding, namely claims 3 through 7, are considered by the examiner to be patentable.

The patent under reexamination relates to a sports racket, such as a tennis racket, having a stringed playing surface. According to claim 1, the only independent claim on appeal, the stringed playing surface comprises first and second pluralities of string segments (23, 24) extending in first and second directions between opposed locations (27, 28) on a frame (11). Claim 1 recites that at least one of the string segments of the second plurality of string segments is interwoven with the outside string segments (33) of the first plurality of string segments to form a pair of nodes (31)[2] adjacent to the opposed locations (27, 28) on the frame.

Claim 1 additionally recites that the aforesaid one string segment of the second plurality of string segments has opposite ends (40) leading away from the nodes to the frame.

[2] The term "node" is defined in the patent specification in column 3, lines 30-38, in column 7, lines 43-47 and in the paragraph bridging columns 7 and 8.

These opposite ends are recited in claim 1 to be splayed in opposite directions away from the center plane (42) of the string area such that one of the opposite ends contacts the inner portion of the frame in front of the center plane and the other opposite end contacts the inner portion of the frame behind the center plane.

A copy of the appealed claims is appended to appellant's brief.[3]

The following references are relied upon by the examiner in support of his rejections under § 102(b):

Lewis (British Patent)	223,151	Oct. 16, 1924
Martel[4] (French Patent)	2,276,845	Jan. 30, 1976

The Stringer's Digest, pages 6, 10 and 12 (1987).

[3] In the appendix to appellant's brief, claims 8 and 9, which were added in an amendment during this reexamination proceeding, have not been underlined as required by 37 CFR § 1.121(f). Likewise, the subject matter added to claim 1 by amendment in this reexamination proceeding has not been underlined in the copy of the claims in the appendix to appellant's brief. Id.

[4] A translation of this French reference is included in the file wrapper for this reexamination proceeding.

Appealed claims 1, 2, 8 and 9 stand rejected ?under 35 U.S.C. § 102(b) by Martel and The Stringer's Digest? (answer, page 3). Appealed claims 1, 2, 8 and 9 additionally stand rejected ?under 35 U.S.C. § 102(b) by Lewis and The Stringer's Digest? (answer, page 3). The Stringer's Digest is relied on by the examiner to support anticipation of the claimed subject matter based on inherency as will be discussed infra.

We have carefully considered the issues raised in this appeal together with the examiner's remarks and appellant's arguments. As a result, we conclude that the rejections of the appealed claims cannot be sustained.

With regard to the rejection based on Martel, there is no disagreement that this reference shows a node and a splayed string end as claimed and described on the left side of the racket as shown in Figure 3 of the reference. However, as correctly pointed out by appellant on page 5 of the brief, there is no showing or other disclosure in Martel pertaining to the arrangement of the strings 5 at the right hand side of the racket frame. In this regard, Figure 3 of the Martel

reference is merely a fragmentary transverse section in that it shows only the left hand portion of the racket.

The examiner concedes that the Martel reference is silent as to the direction in which the transverse string ends are splayed at the right hand side of the racket frame. He correctly observes, however, that the question of whether the end of string 5 at the right hand side of the racket lies on the side of the center plane opposite from the end of the string at the left hand side of the racket depends on whether there is an odd or even number of main strings (i.e., longitudinally extending strings)

in the racket. In particular, the examiner states on page 4 of the answer:

> As can be also clearly seen in Figure 3 of Martel, if string segment 5a crosses an odd number of main strings, both ends of sting segment 5a will lie in front of center plane W-W. However, if sting segment 5a crosses an even number of main strings, then opposite ends of string segment 5a will lie on different sides of the center plane.

Despite the lack of an express disclosure of whether there is an odd or even number of main strings in Martel's racket, the examiner contends that Martel inherently contains an even number of main strings. In support of this position, the examiner relies on the Stringer's Digest publication, stating on pages 4 and 5 of the answer:

> The Stringer's Digest describes a racquet which is typical of the prior art as known by one of ordinary skill. In fact, page 6 of The Stringer's Digest (Note 2) describes that the typical racquet throat can either be open or closed. As seen in Figure 1 of Martel, an open (or Y-shaped) throat is shown. Further, page 10 of The Stringer's Digest (second column, first paragraph) discloses:
>
> To determine where you'll start on an open throat frame, count the number of holes in the bottom of the throat area, inside the Y-break. If you counted 4, 8, or 12 holes, then start at the head. If you find 6 or 10 holes, start at the throat. Note on the Prince Graphite illustration, six holes

> exit at the bottom, inside the Y. Hence you'll begin stringing the Prince Graphite mains from the throat.
>
> As clearly described, the typical racquet throat must have an even number of holes. Because there are an equal number of holes to the right and left of the throat (to maintain racquet symmetry), the racquet frame necessarily has an even number of holes.
>
> The fact that The Stringer's Digest does not even contemplate an odd number of main strings is convincing evidence that an overwhelming majority of tennis racquets known to one of ordinary skill in the art would inherently have an even number of main strings.
>
> Therefore, since The Stringer's Digest teaches only an even number of strings and Martel is silent to the contrary, it necessarily flows from Martel that his racquet has an even number of strings, resulting in opposite ends of a string segment on different sides of a central plane.

Admittedly, a reference need not expressly disclose a particular limitation in a claim to support a rejection based on anticipation if that limitation is inherent in the reference's disclosure. See RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed.

Cir. 1984). However, in relying upon the theory of inherency, the examiner must provide a sound basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent feature necessarily flows from the teachings of the applied reference. See Ex parte Levy, 17 USPQ2d 1461, 1464 (BPAI 1990) and cases cited therein.

In the present case, we agree with appellant that the examiner erred in stating that, as evidenced by the Stringer's Digest, the typical racket known to one of ordinary skill in the art inherently has an even number of main strings as asserted on page 4 of the final office action dated June 26, 1997 and on page 4 of the answer. In the first place, there is no evidence to establish that an even number of main strings as shown in the Stringer's Digest is ?typical.? Furthermore, even if it assumed arguendo that an even number of main strings is ?typical,? it does not necessarily follow that tennis rackets inherently have an even number of main strings. In fact, the record suggests the contrary as evidenced by the prior art exhibits 6 through 10 appended to appellant's brief. In all of these rackets, there is an odd number of main

strings. Furthermore, it was observed at the oral hearing in this appeal that the Dunlap Revelation and the Slasinger XTC rackets both have an odd number of main strings. It is understood that the examiner was made aware of these rackets during prosecution.

At best, therefore, there is only the possibility that the Martel racket has an even number of main strings. However, as stated in In re Oelrich, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981), inherency may not be established by possibilities or even probabilities. For these reasons, we must reverse the
§ 102(b) rejection of the appealed claims based on the Martel reference.

With regard to the § 102(b) rejection of claim 1 based on Lewis, the only limitation argued as a difference over Lewis is the limitation pertaining to the nodes (see pages 13 and 14 of the brief). We agree with appellant that Lewis does not disclose the claimed nodes as defined in appellant's specification. In particular, the third part of the definition

for a node (see the paragraph bridging columns 7 and 8 of appellant's specification) requires each string end 40 to be secured to the frame ?at a location opposite to the side at which the string end contacts the intersecting string segment, the longitudinal string segment 33 nearest the frame, in order to apply tension to the segment, . . .? (emphasis added). In column 8, the specification goes on to state that ?[w]hen the string end is not secured to the frame in this fashion, for the purpose of this invention, a node has not been formed? (emphasis added). This definition cannot be ignored, for it is well established patent law that an inventor may be his own lexicographer where, as here, the patent specification supports the definition which is now asserted. See, e.g., Jonsoon v. The Stanley Works, 903 F.2d 812, 819, 14 USPQ2d 1863, 1870 (Fed. Cir. 1990).

In contrast to the foregoing definition for a node, the ends of Lewis's strings 2, as shown in Figures 1 and 4, are not secured to the frame at a location opposite to the side at which the string ends contact the outermost main strings to

apply tension to the outermost main strings. In fact it would be speculation to assert, as the examiner has done, that tension is somehow applied to the outermost main strings by Lewis's transverse string ends. For these reasons, as well as those set forth on page 14 of the brief, we must also reverse the § 102(b) rejection of the appealed claims based on the Lewis reference.

The examiner's decision rejecting the appealed claims 1, 2, 8 and 9 is reversed.

REVERSED

HARRISON E. McCANDLISH, Senior)
Administrative Patent Judge)
)
)
) BOARD OF PATENT
JAMES M. MEISTER)

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